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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,690	08/06/1999	MASATO TAKEUCHI	49233-(1117)	7128

21874 7590 03/25/2004

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EXAMINER

WON, YOUNG N

ART UNIT	PAPER NUMBER
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2155

25

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/369,690

Applicant(s)

TAKEUCHI ET AL.

Examiner

Young N Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-7 are pending in this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso (US Pat No.6085201 A).

As per claims 1-7, Tso teaches of an information processing device (see col.1, lines 4-7) and a storage medium carrying program readable by a computer (see col.3, lines 21-28), which causes the computer to transmit and receive electronic mail over a

transmission line, comprising of: a screen (see Fig.1, #2) for displaying received electronic mail to a user (see col.4, lines 5-12); a memory means (see Fig.2, #4 and col.3, line 46) for storing answer examples for a reply mail (see col.4, lines 23-24 and col.5, lines 7-9); a content selecting means for presenting a content of received mail and requiring a user to pick therefrom at least one or more portions of contents necessary for preparing a reply to the received mail (see Fig.3, #231, #233, & #235; col.4, lines 31-36; col.5, lines 49-53; and col.6, line 66 to col.7, line 13); an candidate answer message selecting means for requiring a user to select any of the answer examples stored by the memory means (see Fig.3 and col.5, lines 42-48 & 51-60); an answer example adding means for additionally storing the answer example prepared by the reply example preparing means into the memory means (see col.6, lines 59-63); and a reply-mail preparing means for preparing a reply mail by coupling at least one or more portions of contents selected by the contents selecting means with answer examples selected by the answer example selecting means (see Fig.3; Fig.4; and col.6, lines 66-67 to col.7, lines 1-13), wherein said reply e-mail includes said at least one or more portions of said received e-mail (see col.2, lines 59-67). Tso does not explicitly teach setting the sender of the received mail as an addressee of the reply mail and the receiver of the received mail as an addresser of the reply mail, although Tso does teach that one of the response actions can be responding to the writer (see col.4 lines 31-34). Nonetheless, it would be inherit that such a response would entail setting the sender of the received mail as an addressee, to, or the like and the receiver of the received mail as the addresser, from, or the like, as is well known and currently applied in all email systems.

Response to Remarks

3. Although, Tso teaches of a template generated by a template engine, he also teaches that this template engine generates a "context-sensitive" text message corresponding to an *input text string* (see abstract: 1st sentence) and further adds "given an input text passage, such as... a received text message, the template engine can suggest one or more predefined, **context-appropriate** sentences to include in the outgoing text message based on the **actual content** of the input text passage" (see col.2, lines 59-67). One of ordinary skill in the art would argue that the generated text message could in fact contain actual content portions directly received from the input text string and does not exclude such portions. In the example provide in Fig.4 and col.6, lines 6-65, one of ordinary skill in the art would agree that when a template is chosen which "enables a user to compose text messages using dramatically fewer keystrokes than otherwise be required" (see col.6, lines 25-27), contents or portions from the received e-mail that is parsed is included in the reply e-mail.

Conclusion

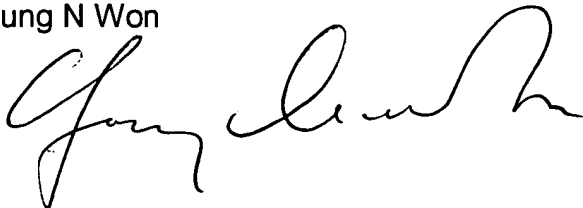
4. The amended claim does not clearly and concretely distinguish over prior art. Therefore, claims 1-7 remain rejected.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Young N Won



March 23, 2004



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER